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EXAMINER
ALI, MOHAMMAD

ART UNIT	PAPER NUMBER
2177	

DATE MAILED: 06/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/815,642	Applicant(s) SZUTU, KEHYEH
	Examiner Mohammad Ali	Art Unit 2177

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *17 March 2004*.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-16* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-16* is/are rejected.

7) ☒ Claim(s) *1 and 12* is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1. This communication is in response to the amendment filed on March 17, 2004, Paper No. 3.

2. Claims 1-16 are pending in this Office Action.

3. Based on Applicant's amendment to the claims the Examiner brings the new art to reject the amended claims as a combination. The new art Schneider's system allows a program to subscriber for configuration of minimum and maximum buffer levels of pre-loading potentially reusable data to the portable storage media (see col. 18, lines 14-17, Figs. 3-4A, Schneider).

4. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

5. Claim12 is objected to because of the following informalities:

in Paper No. 3, in claim 12, in line 5 after the word "selecting" **an** should be substituted by **a**.

Claim 1 also is objected because Applicant's did not underlined all the amendment to the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The analysis under 35 U.S.C. 112, first paragraph, requires that the scope of protection sought be supported by the specification disclosure. The pertinent inquiries include determining (1) whether specification disclosure as a whole is to enable one skilled in the art to make and use the claimed invention.

Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The enablement requires necessitates a determination that the disclosure contains sufficient teaching regarding the subject matter claimed as to enable one skilled in the pertinent art to make and use the claimed invention. In essence, the scope of enablement provided to one ordinarily skilled in the art by disclosure must be commensurate with the scope of protection sought by the claims.

Currently, the most prevalent standard for measuring sufficient enablement to meet the requirements of 112 is that of "undue experimentation". The test is whether, at the time of the invention, there was sufficient working procedure for one skilled in the art to practice the claimed without undue experimentation. It is important to note that the test of enablement is not whether any experimentation is necessary, but whether, if

experimentation is necessary, is it undue. An skilled artisan is given sufficient direction

or guidance in the disclosure. Moreover, the experimentation required, in addition to not

being undue, must not require ingenuity beyond that expect of one of ordinary skill in

the art.

Undue experimentation and ingenuity would be required beyond one of ordinary

skilled in the art to practice: 1) "preloaded program" in claims 1, 10, and 16. Undue

experimentation would be needed to make a preloaded program able to execute a

function for unrelated Independent-unique identifier in the system.

Dependent claims 2-9 and 11-15 are rejected for fully incorporated deficiency

from their independent claims.

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

8.   Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Darin Duphorne ('Duphorne' hereinafter), US Patent 6,212,265 B1 in view of Eric

Schneider ('Schneider' hereinafter), US patent 6,442,549 B1.

With respect to claim 1,

Duphorne teaches method for processing an incoming e-mail (see col. 2, lines 18-29) comprising:

a) receiving said incoming e-mail into a control Web site (see col. 9, lines 15-19, Duphorne) for extracting a code from an Internet-independent unique identifier transmitted from said incoming e-mail (a subscriber having the telephone number (214) 123 –4567 "unique identifier" and having an email server having the Internet address of mailservice.com is alerted by sending an email message addressed to 2141234567@mailservic.com. When email server receives the email message, the email server access an associated lookup table or database to confirm that the user identified by the telephone number subscribes to the email notification service, see col. 10, lines 59-66, Duphorne); and

b) searching a database of said control Web site for using said code to link (utilize email query software for monitoring reception of email at the user's email. In order to query the ISP email server, the query software access the user notification parameter database to retrieve the line entry which corresponds with the user, see col. 5, line 8-16, Duphorne) and execute a preloaded program for carrying out a function unrelated to said Internet-independent unique identifier (the server name in the Internet address or fully qualified domain name "unrelated to Internet-independent unique identifier" operated by the telco or other service provider, see col. 10, lines 56-58, Duphorne).

Duphorne does not explicitly indicate the claimed "preloaded program".

Schneider discloses the claimed step of preloaded program (the program allows subscriber to configure minimum and maximum buffer levels of pre-loading potentially reusable data from the portable storage media, see col. 18, lines 14-17, Figs. 3-4A, Schneider).

It would have been obvious to one ordinary skill in the data processing art, at the time of the present invention to combine the teachings of the cited references, because preloaded program of Schneider's teachings would have allowed Duphorne's system to optimize the on-line transmission size of the time sensitive information to a subscriber to minimizes the use of using portable storage media by buffering or caching data to be used in the near future, as suggested by Schneider, at col. 9, lines 9-14. Further, preloaded program as taught by Schneider improves subsequent deliveries of control data are periodically sent to the subscriber via e-mail or periodically received/downloaded by a subscriber/client device via any network transfer protocol (see col. 17, lines 23-26, Schneider).

As to claim 2,

Duphorne teaches wherein: said step b) of executing a preload program further comprising a step of executing an e-mail forwarding program for forwarding (see col. 5, lines 65-67, Fig. 3, Duphorne) said incoming e-mail to a code-linked e-mail destination having an e-mail address unrelated to said Internet-independent unique identifier (the server name in the Internet address or fully qualified domain name operated by the telco or other service provider, see col. 10, lines 56-62 and col. 4, lines 45-47, Duphorne).

As to claim 3,

Duphorne teaches wherein: said step b) of executing a preload program further

comprising a step of executing an e-mail forwarding program for forwarding (see col. 8,

lines 20-26, Duphorne) said incoming e-mail to at least two code-linked e-mail

destinations having an e-mail addresses unrelated to said Internet-independent unique

identifier (the server name in the Internet address or fully qualified domain name

operated by the telco or other service provider, see col. 10, lines 56-66, Duphorne).

As to claim 4,

Duphorne teaches wherein: said step a) of receiving said incoming e-mail into

said control Web site further comprising a step of receiving said incoming e-mail with a

first part of an e-mail address represented by a telephone number for further processing

and extracting said code (receive the email message from the email server through as

telephone number email address, see col. 10, lines 59 to col. 11, lines 10 and col. 8,

lines 51-55, Duphorne).

As to claim 5,

Duphorne teaches wherein: said step a) of receiving said incoming e-mail into

said control Web site further comprising a step of receiving said incoming e-mail with a

first part of an e-mail address represented by a telephone number and an extension for

further processing and extracting said code (a subscriber having the telephone number

(214) 123 –4567 and having an email server having the Internet address of

mailservice.com is alerted by sending an email message addressed to

2141234567@mailservic.com. When email server receives the email message, the

email server access an associated lookup table or database to confirm that the user

identified by the telephone number subscribes to the email notification service, see col.

10, lines 59-66 and col. 8, lines 51-56 et seq, Duphorne).

As to claim 6,

Duphorne teaches wherein: said step b) of executing a preloaded program

further comprising a step of executing an universal resource location (URL) linking

program for linking a sender of said incoming e-mail to a pre-designated URL (the query

software sends a callerID-compatilble signal to the email notification device when a

Web site "URL" designated by the user and whose Internet address is stored in a

special word in a correspondence line entry of the user notification database when

content of the Web Site is modified, see col. 9, lines 15-19, Duphorne).

As to claim 7,

Duphorne teaches wherein: said step b) of executing a preload program further

comprising a step of executing a message forwarding program for forwarding a

message transmitted in said incoming e-mail to at least two coded-linked message

destinations unrelated to said Internet-independent unique identifier whereby said

control Web site (see col. 9, lines 15-19, Duphorne) is enabled to function as an

universal message in-box (the server name is the Internet address or fully qualified

domain name operated by the telco or other service provide, see col. 10, lines 56-62).

As to claim 8,

Duphorne teaches wherein: said step b) of executing a preload program further

comprising a step of executing a device-command forwarding program for forwarding a

device command to a pre-designated device for carrying out a pre-designated device

function (the email notification device is coupled to one or more compatible peripheral

devices such as, for instance, a stock market ticker device, where commands to operate

such devices and/or information to be displayed on such devices are transmitted

remotely according to a suitably-formatted CallerID-compatible signal transmitted to the

email notification device which, in turn, forwards the commands to the corresponding

peripheral device in a suitable manner, see col. 9, lines 49-57, Duphorne)

As to claim 9,

Duphorne teaches wherein: said step a) of receiving said incoming e-mail into a

control Web site for extracting a code represented by said Internet-Independent unique

identifier further comprising a step of normalized said Internet-independent unique

identifier into said code (a subscriber having the telephone number (214) 123 –4567

and having an email server having the Internet address of mailservice.com is alerted by

sending an email message addressed to <u>2141234567@mailservic.com</u>, 2141234567 is

the "normalized unique identifier" see col. 10, lines 59-66).

With respect to claim 10,

Duphorne teaches a network system (see col. 2, lines 18-29) comprising:

a unified access management center comprising a database for receiving and

linking a network-independent preexisting-unique identifier (when email server receives

the email message, the email server access an associated lookup table or database to

confirm that the user identified by the telephone number "preexisting-unique identifier"

subscribes to the email notification service. If so, the email server sends a callerID-

compatilbe email "forward" notification signal to the user via the local loop of the public

switched telephone network and the notification signal could have all or a predetermined portion of the text of email messages stored on the email server, see col. 10, lines 62 to col. 11, lines 10 and Fig.1, Duphorne) to preloaded program from performing a function not directly related to said network-independent preexisting-unique identifier (the server name in the Internet address or fully qualified domain name "preexisting-unique identifier" operated by the telco or other service provider, see col. 10, lines 56-58, Duphorne).

Duphorne does not explicitly indicate the claimed "preloaded program".

Schneider discloses the claimed step of preloaded program (the program allows subscriber to configure minimum and maximum buffer levels of pre-loading potentially reusable data from the portable storage media, see col. 18, lines 14-17, Figs. 3-4A, Schneider).

It would have been obvious to one ordinary skill in the data processing art, at the time of the present invention to combine the teachings of the cited references, because preloaded program of Schneider's teachings would have allowed Duphorne's system to optimize the on-line transmission size of the time sensitive information to a subscriber to minimizes the use of using portable storage media by buffering or caching data to be used in the near future, as suggested by Schneider, at col. 9, lines 9-14. Further, preloaded program as taught by Schneider improves subsequent deliveries of control data are periodically sent to the subscriber via e-mail or periodically received/downloaded by a subscriber/client device via any network transfer protocol (see col. 17, lines 23-26, Schneider).

As to claim 11,

Duphorne teaches wherein: said unified access management center further comprising an incoming e-mail processor for processing an incoming e-mail designating an e-mail for extracting a code from said network-independent preexisting-unique identifier for linking to said preloaded program (the server name in the Internet address or fully qualified domain name operated by the telco or other service provider, see col. 10, lines 56-66, and col. 4, lines 45-47, Duphorne).

As to claim 12,

Duphorne teaches wherein: said unified access management center further comprising a unified access registration processor for receiving a registration request comprising a network-independent preexisting-unique identifier for selecting an preload program (the server name in the Internet address or fully qualified domain name operated by the telco or other service provider, see col. 10, lines 62 to col. 11, lines 10 and Fig.1, Duphorne).

As to claim 13,

Duphorne teaches wherein: said incoming e-amil processor further comprising a normalizing means for normalizing said network-independent preexisting unique identifier into said code for linking to said preloaded program (the server name in the Internet address or fully qualified domain name operated by the telco or other service provider, see col. 10, lines 56-66, Duphorne).

As to claim 14,

Duphorne teaches wherein: said database further comprising a preloaded

program for forwarding said incoming e-mail to a forwarding address unrelated to said

network-independent preexisting unique identifier (the server name in the Internet

address or fully qualified domain name operated by the telco or other service provider,

see col. 10, lines 56-62, Duphorne).

As to claim 15,

Duphorne teaches said database further comprising a preloaded program for

processing and forwarding (see col. 8, lines 20-26, Duphorne) a message received from

said incoming e-mail to at least two forwarding addresses unrelated to said network-

independent preexisting-unique identifier whereby said unified access management

center functions as an universal message box (the server name in the Internet address

or fully qualified domain name operated by the telco or other service provider, see col.

10, lines 56-66, and Fig. 1, Duphorne).

With respect to claim 16,

Duphorne teaches a network system (see col. 2, lines 18-29) comprising:

a unified access management center having an interactive database for enabling

an Internet user to enter a network-independent preexisting-unique identifier (a

subscriber having the telephone number (214) 123 –4567 "preexisting-unique identifier"

and having an email server having the Internet address of mailservice.com is alerted by

sending an email message addressed to 2141234567@mailservic.com. When email

server receives the email message, the email server access an associated lookup table

or database to confirm that the user identified by the telephone number subscribes to

the email notification service, see col. 10, lines 59-66, Duphorne) for selecting an associated preloaded program not directly related to said network-independent preexisting-unique identifier whereby said Internet user is enabled to execute said preloaded program by sending said network-independent pre-existing unique identifier to said unified access management (the server name in the Internet address or fully qualified domain name operated by the telco or other service provider, see col. 10, lines 56-58, Duphorne)

Duphorne does not explicitly indicate the claimed "preloaded program".

Schneider discloses the claimed step of preloaded program (the program allows subscriber to configure minimum and maximum buffer levels of pre-loading potentially reusable data from the portable storage media, see col. 18, lines 14-17, Figs. 3-4A, Schneider).

It would have been obvious to one ordinary skill in the data processing art, at the time of the present invention to combine the teachings of the cited references, because preloaded program of Schneider's teachings would have allowed Duphorne's system to optimize the on-line transmission size of the time sensitive information to a subscriber to minimizes the use of using portable storage media by buffering or caching data to be used in the near future, as suggested by Schneider, at col. 9, lines 9-14. Further, preloaded program as taught by Schneider improves subsequent deliveries of control data are periodically sent to the subscriber via e-mail or periodically received/downloaded by a subscriber/client device via any network transfer protocol (see col. 17, lines 23-26, Schneider).

Remarks

9. **First**, In response to the Applicant's arguments regarding "preload program now carries out function not directly related to the Internet-independent unique identifier, e.g., a telephone number", the Examiner respectfully submits that in particular, **Duphorne** teaches this limitation as, the server name in the Internet address or fully qualified domain name operated by the telco or other service provider, this particular domain name is not directly related with unique identifier telephone number (see col. 10, lines 56-58). Duphorne does not explicitly indicate the claimed "preloaded program". Schneider teachings should remedy such kinds of deficiency by teaching a program allows subscriber to configure minimum and maximum buffer levels of pre-loading potentially reusable data from the portable storage media, see col. 18, lines 14-17, Figs. 3-4A, Schneider. It would have been obvious to one ordinary skill in the data processing art, at the time of the present invention to combine the teachings of the cited references. The preloaded program of Schneider's teachings would have allowed Duphorne's system to optimize the on-line transmission size of the time sensitive information to a subscriber to minimizes the use of using portable storage media by buffering or caching data to be used in the near future, as suggested by Schneider, at col. 9, lines 9-14. Further, preloaded program as taught by Schneider improves subsequent deliveries of control data are periodically sent to the subscriber via e-mail or periodically received/downloaded by a subscriber/client device via any network transfer protocol (see col. 17, lines 23-26, Schneider).

Second, In response to the Applicant's arguments regarding "a preload program that performs a function not directly related to the network independent preexisting-unique identifier", the Examiner respectfully submits that in particular, **Duphorne** teaches this limitation as, the server name in the Internet address or fully qualified domain name "not directly related to preexisting unique identifier" operated by the telco or other service provider, this particular domain name is not directly related with unique identifier telephone number (see col. 10, lines 56-58). Duphorne does not explicitly indicate the claimed "preloaded program". Schneider teachings should remedy such kinds of deficiency by teaching a program allows subscriber to configure minimum and maximum buffer levels of pre-loading potentially reusable data from the portable storage media, see col. 18, lines 14-17, Figs. 3-4A, Schneider. It would have been obvious to one ordinary skill in the data processing art, at the time of the present invention to combine the teachings of the cited references. The preloaded program of Schneider's teachings would have allowed Duphorne's system to optimize the on-line transmission size of the time sensitive information to a subscriber to minimizes the use of using portable storage media by buffering or caching data to be used in the near future, as suggested by Schneider, at col. 9, lines 9-14. Further, preloaded program as taught by Schneider improves subsequent deliveries of control data are periodically sent to the subscriber via e-mail or periodically received/downloaded by a subscriber/client device via any network transfer protocol (see col. 17, lines 23-26, Schneider).

Hence, Applicants arguments do not distinguish the claimed invention over the prior art of record.

In light of the forgoing arguments, the 103 rejections are hereby sustained.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad Ali whose telephone number is (703) 605-4356. The examiner can normally be reached on Monday to Thursday from 7:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (703) 305-9790 or Customer Service (703) 306-5631. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for any communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

Mohammad Ali

Patent Examiner

AU 2177

MA

May 31, 2004